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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,636	11/14/2003	Alan Glyn Davies	CM2567C	2430

27752 7590 07/22/2005

THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
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CINCINNATI, OH 45224

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,636

Applicant(s)

DAVIES ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status***Li*

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claims 1-8 and 10-15 are pending in the application and the status of the application is as follows:

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-8 and 10-15 are rejected less than 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to an amino functional polysiloxane (A) comprising alternating units of (i) drawn to formula with variables and (ii) a divalent organic moiety comprising at least one nitrogen atom and (iii) a monovalent organic moiety comprising at least one nitrogen atom. The hair compositions are formed using mixture of A and B. There is no description in the specification for the organic moiety, which can be divalent or monovalent. There is no structure given to this moiety. **The specification gives no guidance to one of**

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**ordinary skill in the art the structure of this organic moiety.** The organic moiety includes plethora of compounds.

The expression “ organic moiety” without i.e. partial or complete structure does not convey to one of ordinary skill in the art that applicants were in possession of the claimed subject matter. The language recited without any correlation does not meet the written description requirement for the expression **organic moiety group** as one of ordinary skill in the art could not recognize or understand the **structure from the mere recitation**. Claims employing this language at the point of novelty, such as applicants’, neither provide those elements required to practice the inventions, nor “inform the public” during the life of the patent of the limits of the monopoly asserted. The expression could encompass myriad of compounds and applicants claimed expression represents only **an invitation to experiment regarding possible compounds.**

#### ***Response to Arguments***

3. Applicant's arguments filed 7/10/05 have been fully considered but they are not persuasive.
4. Applicants point out that they have provided written description of the currently claimed amino functional polysiloxane, including the expressions “divalent organic moiety” and “monovalent organic moiety” at pages 4-6 of the specification and applicants admit that they did not explicitly define the expressions with respective chemical structures, but argue that one of ordinary skill in the field of silicone polymers would understand the meaning and scope of these expressions in the context of the entire written description of the currently claimed invention.

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Applicants also point out to page 5, lines 5-12 of the specification where they have provided the suitable ranges for viscosity and molecular weight and argue that one of ordinary skill in the art would know that the selection of a particular divalent organic moiety or monovalent organic moiety would affect parameters such as viscosity and molecular weight.

5. In response to the above argument, the claims define (a) as an **amino functional polysiloxane (A)** comprising *alternating units* of (i) which has a structure, and (ii) a divalent organic moiety comprising at least one nitrogen atom and (iii) monovalent organic moiety comprising at least one nitrogen atom located at terminal position of amino functional polysiloxane. The viscosity and molecular weight at page 5 of the specification is with respect to the amino functional polysiloxane A and not to monovalent organic moiety. See below the text from page 5 of the specification.

*“ Preferably, the viscosity of the **amino functional polysiloxane** should be selected such that it is in a range of from 10 cps to 3000cps, preferably from 100 to 500cps. Whilst not being bound by theory it is believed that viscosity is proportional to polymer molecular weight and inversely proportional to the degree of branching. Viscosity will impact spreading on hair and ease of processing in the composition. Thus molecular weight also influences both of these important parameters. The molecular weight of said **amino functional polysiloxane** is preferably from 1000 to 50000, more preferably from 1500 to 35000”.*

Therefore the viscosity and molecular weight is not defined for (ii) or (iii), but to the entire polysiloxane A. There is no structure for (ii) and (iii) admitted by applicants and the specification fails to define the physical properties of these two moieties and one of ordinary skill in the silicone art would not know which moiety to select in order to arrive at the claimed molecular

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weight or viscosity of the polymer A. Note that the structure A is to a polymer and not to simple molecules. Additionally the specification at page 6 describes that these compounds can be prepared by known methods and fails to describe the starting materials so that one of ordinary skill in the art would arrive at the final product or to the document to guide one skilled in the art for the preparation of these polymers. The example at page 27 describes structure of the polysiloxane but it does not correspond to polysiloxane A since A should have alternating units of (i) and (ii) and (iii). Therefore there is neither description nor exemplification and the specification fails to comply with the written description for polysiloxane A since it does not describe the organic moieties (ii) and (iii) which are part of the polysiloxane A.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'J. Venkat', written in a cursive style.

**JYOTHSNA A VENKAT Ph. D**

**Primary Examiner**

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